

**REMARKS**

Claims 1-9, 12 and 16-19 are pending in this Application. Claims 10-11 and 13-15 have been previously canceled without prejudice. In the Office Action mailed June 5, 2006, the Examiner asserted the following:

- rejected Claims 1-9, 12 and 16-19 under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 132 for including new matter;
- rejected Claims 1-9, 12 and 16-19 under 35 U.S.C. § 103(a) as being unpatentable over JP 60192074 (abstract, Matsushita Electric Works Ltd; herein "Matsushita"), U.S. Patent No. 6,332,921 (herein "Brothers") or Liskowitz et al. (WO 97/21640; herein "Liskowitz");
- rejected Claims for obviousness-type double patenting as being unpatentable over Claims 1-9, 12, and 16-19 of U.S. Patent No. 6,749,897.

Applicants first thank the Examiner for holding an Interview on July 11, 2006, to discuss the final Office Action and various aspects therein.

From the Interview, it was agreed that the new matter rejection under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 132 is against Claim 16 only and not against Claims 1-9, 12 and 17-19. Accordingly, Applicants point out that the phrase "dewatering occurs in at least about 120 seconds" is well supported by the specification, such as in the Examples (see Application Publication No. 20020170467), including: Example 1,

para. [0064], in which it is disclosed, "The slurry dewatered in 90 seconds (un-aided by vacuum) forming a 1.25 mm thick coating;" Example 2, para. [0066], in which it is disclosed, "The slurry dewatered in 60 seconds (un-aided by vacuum) forming a 1.25 mm thick coating;" and Example 3, para. [0068], in which it is disclosed, "The slurry dewatered in 120 seconds (un-aided by vacuum) forming a 1.25 mm thick coating." As such, Applicants submit that Claim 16 is not new matter and respectfully request the Examiner remove the rejection under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 132.

In the Interview of July 11, 2006, Applicants and the Examiner also discussed the rejection of Claims 18 and 19, claims that had been newly entered in an Amendment dated April 6, 2006, in order to claim subject matter stated to be allowable by the Examiner in the Office Action mailed October 6, 2005. The Examiner indicated that for Claims 18 and 19 to be allowable, claims are to include language describing a second portion as a remainder of what is not used for the first portion. It was further suggested by the Examiner that the phrase "at least" should be removed. Accordingly, Applicants, taking the Examiner's suggestions, have amended Claims 18 and 19 to remove the phrase "at least" and to provide language in accordance with the Interview and the Office Action mailed October 6, 2005. Applicants respectfully submit amended Claims 18 and 19, believed to be in allowable form and respectfully request the rejection under 35 U.S.C. § 103(a) be removed. Applicants also respectfully submit new Claim 20, believed to be distinguishable from the cited art and to protect subject matter believed to be Applicants' invention.

In addition to the above, Applicants and the Examiner discussed the rejection of Claim 1 under 35 U.S.C. § 103(a) in the Interview of July 11, 2006. The Examiner noted that, in one form, Applicants' invention is for coating a building board, and further indicated that none of the cited references provided such a teaching. It is the Applicants' understanding that the Examiner agreed to remove the cited references should Claim 1 be amended to recite that the method is for coating a building board because such a claim would be distinguishable from the cited references. Accordingly, Applicants respectfully submit amended Claim 1, amended in accordance with the Examiner's suggestion. Amended Claim 1 is believed to be distinguishable from the cited references because the invention of Claim 1 as a whole is not obvious over the cited references of Matsushita, Brothers or Liskowitz. Neither Matsushita, Brothers nor Liskowitz provide a method of improving an hydraulic binder based coating formulation for coating a building board nor is there any suggestion or motivation in the references themselves or to one of ordinary skill in the art to modify the reference teachings (or combine them, for that matter) to make Applicants' claimed invention. Matsushita teaches only a general proposed hardenable body of cement with no known properties, no specific guidance as to the composition of the hardenable body, nor any suggestions or known methods of use. Brothers teaches only well cement requiring calcium aluminate, sodium polyphosphonate, a set retarder, and Class F fly ash at 25% to 45% by weight of the well cement, the composition prepared only to resist deterioration in brines, to delay setting, and to endure extremely high temperatures. Liskowitz teaches only high-compressive strength concrete and

mortar, each requiring fly ash having a diameter of less than 11 microns with a median particle diameter of 4 microns used to replace about 25% of the cement or mortar, and the concrete or mortar prepared only for use as concrete or mortar with greater compressive strength after 7 to 14 days of curing. Because these cited references do not teach or suggest the claimed invention as a whole and because there is no suggestion or motivation to modify the reference teachings, there is no reasonable expectation of success. Furthermore, none of the cited references teach or suggest all the claims limitations of amended Claim 1, including adding to a hydraulic binder a dewatering agent and water and said dewatering agent comprising fly ash and the fly ash further comprising a first portion having a maximum particle diameter of around 10 microns in the amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients and a second portion of a different size range having a maximum particle diameter of around 100 microns in the amount of 10 to 60 wt.% of the formulation based on the total dry ingredients, and such that after application of a slurry of said formulation to said first surface of said building board, said slurry is dewatered through the building board to said second surface of said building board. For these reasons, Applicants submit that amended Claim 1 is not obvious over the cited references. Applicants, therefore, agree with the Examiner and respectfully request entry of amended Claim 1. Applicants have further amended Claim 1 to include water, as suggested by the Examiner on page 3 of the Office Action. In addition, Applicants have amended Claim 1 to make clear the two portions of fly ash which also overcomes the Examiner's assertions on page 3 of the Office Action. Support for "a second portion of

a different size range" may be found throughout the specification, at, for example, para. [0034].

The Examiner, on page 2 of the Office Action, asserts that the cited reference provide a coating for covering a building material by noting that "both concrete and mortar (especially mortar which is applied by troweling or even spraying) can still be coatings." However, Applicants submit that the Examiner has provided no factual evidence that the hardenable body of Matsushita or the well cement of Brothers or the concrete and mortar of Liskowitz each provide methods of improving an hydraulic binder based coating formulation for coating a building material or board (nor is there any factual evidence that the references provide methods wherein the methods include adding to a hydraulic binder a dewatering agent and water and said dewatering agent comprising fly ash and the fly ash further comprising a first portion having a maximum particle diameter of around 10 microns in the amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients and a second portion of a different size range having a maximum particle diameter of around 100 microns in the amount of 10 to 60 wt.% of the formulation based on the total dry ingredients, and such that after application of a slurry of said formulation to said first surface of said building product or board, said slurry is dewatered through the building product or board to said second surface of said building product or board). For a *prima facie* case of obviousness, the Examiner must present a convincing line of reasoning and evidence as to why one of skill in the art would have found the claimed invention for a method of improving an hydraulic binder based coating formulation for coating a

building material or board to have been obvious *in light of the teachings of each reference*. None of the above references cited teach or suggest all the claims limitations of amended claim 1 nor do any of the cited references teach that their compositions are hydraulic binder based coating formulation for coating a building material or board. As such, there is no justification for one of skill in the art to modify the cited reference to be used as a hydraulic binder based coating formulation for coating a building material or board. Instead, the Examiner is

proposing that to provide Applicants' claimed invention, the principles of operation of the prior art inventions be changed, which is not appropriate for a showing of obviousness. This is because the Examiner is requiring a substantial reconstruction or addition of elements as originally disclosed in the cited references. However, no proposed modification can require a substantial reconstruction of the elements or a change in the basic principle under which each of the primary references were designed to operate.

On page 3 of the Office Action, the Examiner asserts that "Applicants have also not shown how their use of two allegedly different sized fly ash leads to any criticality or unexpected result." Applicants respectfully disagree and submit that, as stated previously, one such result is a dewatering through the building product or board as well as providing a dewatering that occurs in at least about 120 seconds. Additional results are provided in the specification, at, for example, paragraphs [0024]-[0028] and [0044]-[0051] of Application Publication No. 200201704674.

The Examiner further asserts on page 3 of the Office Action that "applicants' independent claims merely read upon mixing fly ash and hydraulic cement which is old in the art." Applicants firstly respectfully disagree that this is a fair representation of Applicants claimed invention and submit that, as such, the Examiner's position is not relevant to Applicants' claimed invention. If Applicants' claimed invention were, in fact, old in the art, Applicants respectfully request the Examiner provide such factual evidence of an invention having all the claim limitations of amended Claim 1, should it exist.

On page 5 of the Office Action, the Examiner identifies prior art that could also have been used against Applicants' claims. Applicants respectfully submit that none of the cited references teach or suggest all the claim limitations of amended Claim 1. For the reasons set forth above, Applicants' respectfully request entry and allowance of amended Claim 1 and all claims depending therefrom, namely Claims 2-9, 12 and 16-17.

On page 7 of the Office Action Claims 1-9, 12 and 16-19 were rejected on the grounds of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,749,897. Applicants respectfully request the rejection be held in abeyance until there is allowable subject matter.

With this Amendment, Applicants are intending to bring prosecution to a speedy conclusion. No new matter has been included with this reply and no new issues requiring further consideration and/or search have been introduced with the amendments set forth herein.

### CONCLUSION

Applicants respectfully submit that the Application is in condition for allowance, and pursuant to the filing of this Amendment and a Request for Continued Examination, Applicants earnestly seek such allowance of Claims 1-9, 12 and 16-19 and new Claim 20 as provided in the Listing of Claims beginning on page 3 of this paper. Should the Examiner have questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' representative at 214.999.4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application.

To the extent that any further fees are required during the pendency of this Application, including petition fees, the Commissioner is hereby authorized to charge payment of any additional fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 131279-1019. In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time enclosed herewith, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the



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AMENDMENT WITH RCE  
Serial No. 10/090,561

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Deposit Account referenced above. Please credit any  
overpayments to this same Deposit Account.

This is intended to be a complete response to the Office  
Action made final and mailed June 5, 2006.

**Please direct all correspondence to the practitioner listed  
below at Customer No. 60148.**

Respectfully submitted,



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Dated: December 5, 2006